UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,059	04/26/2001	Rabindranath Dutta	AUS920010411US1	8459

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EXAMINER
CHEN, CHONGSHAN

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/843,059	DUTTA ET AL.
	Examiner	Art Unit	
	Chongshan Chen	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12 November 2004*.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4,7-10,13-16 and 19-24* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-4,7-10,13-16 and 19-24* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications filed on 12 November 2004. Claims 1-4, 7-

10, 13-16 and 19-24 are pending in this Office Action.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claims 1-4, 7-10, 13-16 and 19-24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Olah et al. (hereinafter "Olah", US 6,446,119 B1) in view of Pavley et al.

(hereinafter "Pavley", US 6,317,141 B1).

As per claim 1, Olah teaches a method for displaying, at a client, transient messages

received over a network, the method comprising:

storing in a chronological list, independently of a user action, a plurality of different

multimedia objects each containing at least one transient message when each multimedia object

is initially rendered at the client (Olah, col. 4, lines 32-33, screen captures are executed and

saved to a log, log stores data in an first in first out order, which is a chronological list).

Olah teaches displaying the captured screen images, but does not explicitly disclose

displaying the chronological list with control buttons for enabling a subsequent rendering of the

stored multimedia objects in at least one of a forward and backward succession, at a user

configurable rate, in response to a user selection of one of the displayed control buttons, wherein

the displayed control buttons are independent of any playback control displayed in conjunction with initially rendering a given multimedia object. Pavley discloses creating a slide show for the captured screen images (Pavley, col. 2, lines 15-20). A slide show such as Microsoft PowerPoint displays a list of multimedia objects and plays the list of multimedia objects in a forward succession at a user configurable rate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Olah by incorporating the Microsoft PowerPoint program as disclosed by Pavley. The motivation being to allow the user to use Microsoft PowerPoint to create a slide show for the images in the activity log of Olah and play the captured multimedia objects in a forward succession at a rate specified by user. This is much convenient for the user because the user does not need to select and play the multimedia object one by one.

As per claim 2, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach each one of the plurality of different multimedia objects is at least one of an animated GIF multimedia object, a moving picture type multimedia object, a vector graphic multimedia object, and a static image multimedia object (Olah, col. 4, lines 32-35).

As per claim 3, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at least one of the multimedia objects at the client (Olah, col. 5, lines 46-60).

As per claim 4, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at least one of the multimedia objects at a server which is in communication over the network with the client (Olah, col. 5, line 61 – col. 6, line 16).

As per claim 7, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach the storing step occurs for a configurable duration of time (Olah, Olah, Fig. 2-3).

As per claim 8, Olah and Pavley teach all the claimed subject matters as discussed in claim 1, and further teach storing at a server, which is communicatively connected over the network with the client, each of the multimedia objects in the chronological list as each multimedia object is initially rendered at the client (Olah, col. 4, lines 32-35, col. 5, line 61 – col. 6, line 4).

As per claim 9, Olah and Pavley teach all the claimed subject matters as discussed in claim 8, and further teach sending a given one of the different multimedia objects from the chronological list and a corresponding software unit to enable the multimedia object to be played in response to a selection of a replay button sent from the server to be displayed at the client in conjunction with the multimedia object in an area of a document allocated to the multimedia object (Olah, col. 5, line 46 – col. 6, line 16).

Claims 10, 13-16 and 19-20 are rejected on grounds corresponding to the reasons given above for claims 1-4 and 7-9.

4.   Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engle et al. (hereinafter "Engle", Pub. No.: US 2004/0024640 A1) in view of Moore et al. (hereinafter "Moore", Pub. No.: 2001/0039546 A1) and further in view of Pavley et al. (hereinafter "Pavley", US 6,317,141 B1).

As per claim 21, Engle discloses a method for redisplaying, at a client, at least one transient message displayed in a browser, the method comprising:

identifying a region associated with the at least one transient message (Engle, page 1,

[0013]-[0014]);

clipping the region associated with the at least one transient message (Engle, page 1,

[0013]-[0014]).

Engle does not explicitly disclose storing, independently of a user action, each transient

message when each transient message is initially rendered by the browser. Moore teaches

storing the transient messages/advertisements when the transient messages/advertisements are

initially rendered by the browser independent of a user action (Moore, page 1, [0011]-[0013]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the advertisement capturing system of Engle by replacing the capturing

module of Engle with the capturing module of Moore which stores the transient messages when

the transient messages are initially rendered by the browser independent of a user action. The

motivation being to provide an automatic system which displays and captures advertisement on

the browser. This automatic system saves the user time for manually displaying and capturing

the advertisement on the display.

Moore teaches capturing and storing the transient messages/advertisements (Moore, page

1, [0011]-[0013]), however, Moore discloses the object and local origination data are stored by

local database application 104 into appropriate fields in a new object record, or if the object had

previously been captured, the existing object record is updated (Moore, page 4, [0044]).

Therefore, the captured objects in Moore are not stored in a chronological list. Engle teaches

capturing advertisements and storing the captured advertisements according to user-defined

criteria (Engle, page 2, [0020]), which includes the user-defined option to store the captured

advertisement in a chronological list without updating the existing stored advertisement.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the system of Moore by replacing the storing method of Moore with the

storing method of Engle which stores the captured advertisements in a chronological list without

updating the existing stored advertisements. The motivation being to store all the advertisements

into a history log to provide a history of advertisements displayed on the browser.

Both Engle and Moore disclose replaying the captured advertisements (Engle, page 2,

[0020], Moore, page 1, [0011]-[0013]). However, neither Engle nor Moore explicitly disclose

displaying the chronological list with control buttons for enabling a subsequent rendering of the

transient messages in at least one of a forward and backward succession, at a user configurable

rate, in response to a user selection of one of the displayed control buttons, wherein the displayed

control buttons are independent of any playback control displayed in conjunction with initially

rendering a given transient message. Pavley discloses creating a slide show for the captured

objects (Pavley, col. 2, lines 15-20). A slide show such as Microsoft PowerPoint displays a list

of multimedia objects and plays the list of multimedia objects in a forward succession at a user

configurable rate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the Engle and Moore's combined system by incorporating the

Microsoft PowerPoint program as disclosed by Pavley. The motivation being to allow the user

to use Microsoft PowerPoint to create a slide show for the captured advertisements and play the

captured advertisements in a forward succession at a rate specified by user. This is much

convenient for the user because the user does not need to select and play the advertisements one

by one.

As per claim 22, Engle, Moore and Pavley teach all the claimed subject matters as

discussed in claim 21, and further teach comprising associating a separate identifier for each

stored transient message; and enabling a use of the identifier for the user selection (Engle, page

2, [0024]).

Claims 23 and 24 are rejected on grounds corresponding to the reasons given above for

claim 21.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-4, 7-10, 13-16, 19 and 20, Engle does not

teach or suggest storing in a chronological list, independent of a user action, multimedia objects

when each multimedia objects is initially rendered at the client have been considered but are

moot in view of the new ground(s) of rejection.

6.   As per applicant's arguments regarding claims 21-24, Engle does not teach or suggest

storing in a chronological list, independent of a user action, multimedia objects when each

multimedia objects is initially rendered at the client have been considered and are persuasive.

Therefore, the rejection has been withdrawn. However, upon further consideration, a new

ground(s) of rejection is made in view of Moore et al. (Pub. No.: US 2001/0039546 A1). Please

see the detailed rejection above.

7.   As per applicant's arguments regarding Pavley does not teach displaying a chronological

list with control buttons for enabling subsequent rendering of the stored multimedia objects have

been considered but are not persuasive. Pavley teaches the user may import the images and

video directly into a presentation program, such as Microsoft PowerPoint™ (Pavley, col. 2, lines

15-17), and create a slide show (Pavley, col. 8, lines 53-64). Microsoft PowerPoint displays a

list of captured and stored image objects and control buttons for replaying the images in a slide

show (Please see the Figure 1 below). Figure 1 shows Microsoft PowerPoint program with

control button to play the list of captured and stored images in a slide show. In the left panel of

the Figure 1, Microsoft PowerPoint displays the list of captured and stored image objects. Since

Olah and Engle teach capturing and storing images in a chronological list and Pavley teaches

importing the images into Microsoft PowerPoint and creating a slide show, Microsoft

PowerPoint creates a slide show with the images in chronological list and displays the

chronological list in the left panel of Figure 1. Microsoft slide show displays the chronological

list of captured and stored images in forward succession at a user configurable rate (Pavley, col.

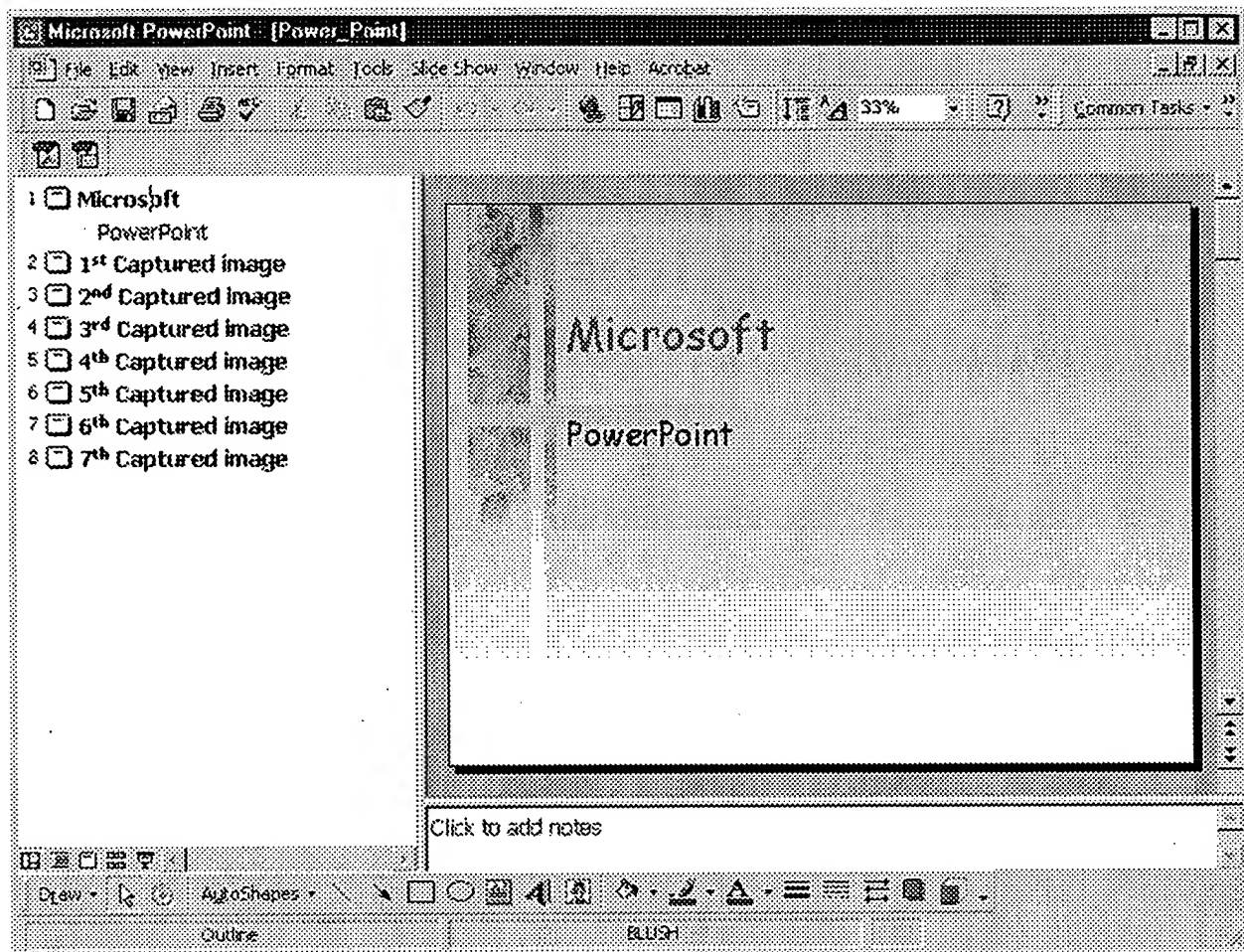15, line 65 – col. 16, line 2). Therefore, the arguments are not persuasive.

Figure 1

8.   As per applicant's arguments regarding the specified duration of playback in Pavley is for

each individual media object, and not "the chronological list ... of stored multimedia objects ...

at a user configurable rate" have been considered but are not persuasive. Microsoft PowerPoint

allows the user to set a fixed duration for displaying each multimedia objects for a slide show

(Pavley, col. 15, line 65 – col. 16, line 2), then Microsoft PowerPoint displays the list of

multimedia objects in forward succession at the rate set by the user.

9.   As per applicant's arguments regarding Pavley teaches "in the case of slide show 360

created as metadata file, the slide show is played … in the order listed in the file" (Pavley, col.

11, line 66 – col. 12, line 5), thus Pavley does not teach "displaying the chronological list with

control buttons for enabling a subsequent rendering of the stored multimedia objects … have

been considered but are not persuasive. Please note the underlined phrase "in the case of" in the

quoted section, Examiner argues the slide show created as metadata file is just one of type of

slide show. Since Olah and Engle teaches storing the multimedia objects in a chronological list,

and Pavley teaches importing the multimedia objects directly into Microsoft PowerPoint (Pavley,

col. 2, lines 15-18). Therefore, the slide show created by the combined system of Olah or Engle

with Pavley discloses displaying the chronological list with control buttons for enabling a

subsequent rendering of the stored multimedia objects.

10.   In response to applicant's argument that there is no suggestion to combine the references,

the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Olah teaches capturing screen images and storing the captured images in a log for

later review. Pavley teaches using Microsoft PowerPoint to import images and create slide

show. Microsoft PowerPoint slide show plays a list of images in forward succession at a rate

specified by the user. Therefore, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to modify the system of Olah by incorporating the Microsoft

PowerPoint program as disclosed by Pavley. The motivation being to allow the user to use

Microsoft PowerPoint to create a slide show for the images in the activity log of Olah and play

the captured images in a forward succession at a rate specified by user. This is much convenient

for the user because the user does not need to select and play the images one by one. The same

reason applies to the combined system of Engle, Moore and Pavley.

Contact Information

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Chongshan Chen whose telephone number is (571)272-4031.

The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John E Breene can be reached on (571)272-4107. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chongshan Chen
April 16, 2005

JEAN M. CORNIELUS
PRIMARY EXAMINER